

ShaoHui et al.

S/N: 10/707,768

REMARKS

Claims 1-22 are pending in the present application. In the Office Action mailed January 11, 2005, the Examiner withdrew claims 9-22 from consideration. Applicant believes that withdrawal of claims 9-22 from further consideration was improper, and files concurrently herewith a Petition for Supervisory Review under 37 C.F.R. §1.144. The Examiner also rejected claims 1 and 3-8 under 35 U.S.C. §102(b) as being anticipated by Kaufman et al. (USP 5,317,293). Claim 2 was objected to as depending from a rejected base claim, but was deemed allowable if rewritten in independent form.

Applicant appreciates the Examiner's indication of the allowability of claim 2. New independent claim 23 has been added which recites the subject matter of claim 2 in independent form.

The Examiner rejected claim 1 as anticipated by Kaufmann et al. As to the "plurality of magnetic elements" of claim 1, the Examiner cited Figs. 1, 2, and 9 of Kaufmann et al. In regard to the "non-magnetizable pane," the Examiner stated that "the cured resin [of Kaufmann et al.] will create a non-magnetizable pane." However, Applicant disagrees and does not believe that Kaufmann et al. teaches a non-magnetizable pane in satisfaction of claim 1.

To clarify this point, Applicant amended claim 1 to call for "an adhesive to secure the non-magnetizable pane to at least a portion of the plurality of magnetic elements." Kaufmann et al. teaches a plurality of magnetic elements that have a liquid filler material flowed thereover that cures to a hardened state. See Abstract/ Kaufmann et al. does not also teach or suggest a non-magnetizable pane retained with an adhesive. Although the resin 60 of Kaufmann et al. may have adhesive properties, Kaufmann et al. does not teach or suggest that the resin 60 secures a separate non-magnetizable pane to a plurality of magnetic elements. Thus, Kaufmann et al. does not teach or suggest each and every element of claim 1.

In addition, with regard to claims 3-8, the Examiner stated that Kaufmann et al. teaches "a non-magnetizable nylon resin pane." (Emphasis added.) However, nowhere in Kaufmann et al. is the word "nylon" used or any other suggestion provided. Therefore, Kaufmann cannot anticipate at least claim 4. In any event, since claim 1 has been shown to be patentable over the art of record, all claims depending therefrom are patentable pursuant to the chain of dependency.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. In accordance with Applicant's Petition Under 37 C.F.R. §1.144 Seeking Supervisory Review of Restriction Requirement, Applicant

ShaoHui et al.

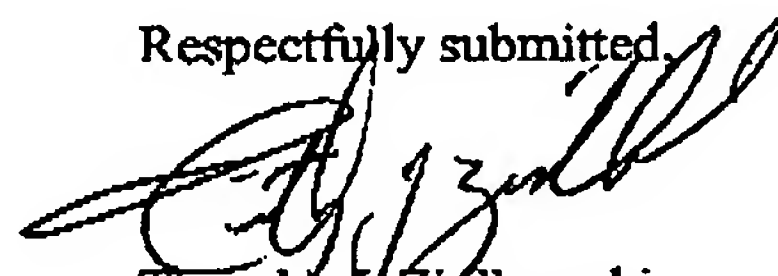
S/N: 10/707,768

respectfully requests rejoinder of all claims. Incidentally, Applicant notes that the Examiner's basis for maintaining the restriction was that claim 1 called for the non-magnetizable pane to be "operationally connected to limit separation of one magnetic element from another magnetic element." While finding a mere difference between the claims is never sufficient to sustain a restriction, Applicant has removed this terminology from the claim since it was deemed unnecessary. Accordingly, the Examiner's basis for restriction is eliminated. However, it is noted that simply finding one element in a claim that is different from another claim is not a basis for restriction -- it is the basic definition of a combination and subcombination. Simply having a combination and subcombination, alone, does not support a restriction.

Applicant hereby authorizes charging of deposit account no. 07-0845 the additional fee of \$250.00 associated with entering the aforementioned new claim 23.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



Timothy J. Ziolkowski
Registration No. 38,368
Direct Dial 262-376-5139
tjz@zpspatents.com

Dated: March 11, 2005
Attorney Docket No.: GEMS8081.189

P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170